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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,028	01/17/2001	Andrew J. Hirsch	NC25587	8883

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EXAMINER

NGUYEN, VAN H

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/765,028

Applicant(s)

HIRSCH, ANDREW J.

Examiner

VAN H NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. This Office Action is in response to the application filed on January 17, 2001. Claims 1-13 are presented for examination.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 8, lines 10-11, the limitation "*said input circuitry*" lacks antecedent basis.

Dependent claims 9-13 are rejected for fully incorporating the deficiencies of their base claim.

### *Double Patenting*

3. **Obviousness-type double patenting rejection**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Uogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

"Double patenting rejection of application claims was fully justified where applicant, in course of expanding first application to disclose enough more by way of details, alternatives, and additional uses to support broad, dominating, generic claims in later applications, has disclosed no additional invention or discovery other than that what was already claimed in patent on first application; there is significant difference between justifying broadening of claims and disclosing additional inventions." *In re Van Ornum*, 214 USPQ (CCPA 1982).

**4. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of application 09/216,749 filed December 16, 1998, now U.S. Patent 6,199,158.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because of corresponding language that recites many of the same elements and functions claimed in the previously patented invention, e.g., "*an apparatus for configuring a electronic device for operation,*" "*a memory device for storing a plurality of sets of configuration data,*" "*an input device for receiving identity data,*" "*receiving identity data from a subscriber identity module,*" "*a Global System for Mobile Communication (GSM) subscriber identity module,*" "*determining a mobile country code/mobile network code (MCC/MNC) from said identity data,*" "*a system identification/system operator Code.*" etc.

The claimed differences would be obvious to a programmer of ordinary skill because the instant claims are merely broader variations of the claims recited in the previously patented invention, e.g., **independent claim 8 of the instant application more broadly claims:**  
*an apparatus for configuring a electronic device for operation, said apparatus comprising:*

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*- a memory device for storing a plurality of sets of configuration data in said electronic device, each of said plurality of sets of configuration data defining an operating configuration for said electronic device;*

*- an input device for receiving identity data at said electronic device; and*

*- a processor coupled to said memory device and said input device, said processor for receiving said identity data from said input circuitry, determining a selected set of said plurality of sets of configuration data based on said identity data, and configuring said electronic device for operation according to said selected set of configuration data*

**as opposed to**

*an apparatus for configuring a electronic device for operation, said apparatus comprising:*

*- a memory device for storing a plurality of sets of configuration data in said electronic device, wherein said plurality of sets of configuration data comprises a plurality of sets of variant configuration data, each associated with at least one identifier of a set of identifiers and a set of default configuration data, and wherein each of said plurality of sets of configuration data defines an operating configuration for said electronic device;*

*- an input device for receiving identity data at said electronic device; and*

*- a processor coupled to said memory device and said input device, said processor for receiving said identity data from said input device, determining a selected set of said plurality of sets of configuration data by determining if said identity data from said input device matches an identifier associated with any of said plurality of sets of variant configuration data, and configuring said electronic device for operation according to said selected set of configuration data*

**as claimed in independent claim 8 of the previously patented invention.** Because the instant claims merely eliminate limitations from the set of elements and functions claimed in the

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previously patented invention, such modifications would be readily apparent to a programmer of ordinary skill.

***Terminal Disclaimer***

5. A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H NGUYEN whose telephone number is (703) 306-5971. The examiner can normally be reached on Monday-Thursday from 8:30AM - 6:00PM. The examiner can also be reached on alternative Friday.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

**Any response to this action should be mailed to:**

**Commissioner for Patents**

**PO Box 1450**

**Alexandria, VA 22313-1450**

**or fax to:**

(703) 746-7239 (for formal communications intended for entry)

(703) 746-7238 (for After Final communications)

(703) 746-7240 (for informal or draft communications)

VHN  
09/26/03



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